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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT PAPER NUMBER

1615

DATE MAILED: 08/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/019,331

Applicant(s)

SAMAIN ET AL.

Examiner

JYOTHSNA A. VENKAT Ph. D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/25/05 has been entered.

Claims 21-52 are pending in the application and the status of the application is as follows:

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claim 37 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a new matter rejection.**

2. There is no support in the specification for “ketones, alkyl acetates, and di-alkoxy substituted alkanes”. The specification describes at page 10, 2nd paragraph two compounds under ketones, which are acetone and methyl ethyl ketone. The same is true for acetates and di-alkoxy

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substituted alkanes. Description for two specific compounds in each category is not a support for the entire genus.

Response to Arguments

3. Applicant's arguments filed 5/25/05 have been fully considered but they are not persuasive.
4. In traversing the rejection applicants argue that the written description requirement for claims to a genus may be met by the disclosure of a representative number of species within that genus and the recitation of at least two species contained within each genus, combined with the permissive language of the description, provides plenty of support for one of ordinary skill in the art to recognize that the inventors had possession of the claimed subject matter.
5. In response to the above argument, the expression claimed includes myriad of compounds in each class of solvents. Description for two compounds is not a support for the entire genus and applicants are in possession of the subject matter drawn to one two compounds in each category and therefore claim 37 does not comply with U. S. C. 112, first paragraph drawn to new matter.

Applicants are notified that the 102 (b) rejection, addressed below is not based upon inherency, but for the reason that the patent office is not equipped to verify the criteria recited in the claim. Therefore in view of new reason for the 102 (b) rejection, the examiner will not address the applicants arguments based upon inherency discussed in the previous office action.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 21-26, 28-38, 42, 47, 49 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. patent 5,053,221 ('221).

CLAIM CONSTRUCTION

The claims are drawn to compositions and claims recite the functional language, which is *when the composition is dried, the resulting dried material has detachment profile defined by at least one maximum detachment force F_{max} of greater than 1N., wherein F_{max} , as measured by extensometer, is the maximum tensile force needed to detach the surfaces of two respective rigid, inert, nonabsorbent supports (A) and (B), wherein said surfaces have each have a surface area of*

38 mm² and wherein said supports are placed facing each other: and further wherein:

said surfaces are precoated at a concentration of 53/c micrograms/mm² with a formulation comprising said at least one adhesive polymer in the cosmetically acceptable medium, where in c is the concentration of solids in the formulation, expressed in grams per gram of composition ; and

said precoated surfaces are dried for 24 hours at 22^o C, under a relative humidity of 50%, then subjected for 20 seconds to a compression of 3N, and then subjected to detachment at a speed of 20 mm/minute for 30 seconds to determine F_{max} .

The office is not equipped to manufacture the composition and then drying the composition and verify so that the composition satisfies the functional criteria of claims 21-26. Therefore the claims are anticipated. The method claims are rejected based upon the

expression” method of coloring the hair”. Mascara is coloring hair since eyelashes have hair. The same is true for claim 52.

See col.2, lines 30-45 for the beads, which read on the claimed particles. See col.2, lines 38-39 where the patent discloses that when “ the silica beads are the only micro sphere particles. “There is overlap of concentration and particle size. See the paragraph bridging col.s 3-4 for the adhesive polymer and see col.4, lines 18 et seq and col.5, lines 1-60 for the AQ polymers. The polymer disclosed in the patent reads on the claimed adhesive polymer. See the examples for ethanol which read on the solvent, see col5, lines 60 et seq and col.6 for the additives.

8. Claims 21-27, 30-33, 38, 42, 47,49 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. patent 5,053,221 ('221).

CLAIM CONSTRUCTION

The claims are drawn to compositions and claims recite the functional language, which is *when the composition is dried, the resulting dried material has detachment profile defined by at least one maximum detachment force F_{max} of greater than 1N., wherein F_{max} , as measured by extensometer, is the maximum tensile force needed to detach the surfaces of two respective rigid, inert, nonabsorbent supports (A) and (B) , wherein said surfaces have each have a surface area of*

38 mm² and wherein said supports are placed facing each other: and further wherein:

said surfaces are precoated at a concentration of 53/c micrograms/mm² with a formulation comprising said at least one adhesive polymer in the cosmetically acceptable medium, where in c is the concentration of solids in the formulation, expressed in grams per gram of composition ; and

said precoated surfaces are dried for 24 hours at 22⁰ C, under a relative humidity of 50%, then

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subjected for 20 seconds to a compression of 3N, and then subjected to detachment at a speed of 20 mm/minute for 30 seconds to determine F_{max} .

The office is not equipped to manufacture the composition and then drying the composition and verify so that the composition satisfies the functional criteria of claims 21-26. Therefore the claims are anticipated. The method claims are rejected based upon the expression" method of coloring the hair". Mascara is coloring hair since eyelashes have hair. The same is true for claim 52. claims are rejected based upon claim 27 limitation.

See examples for silicone powders, which read on the particles wher in the particles are in the form of powders. See the paragraph bridging col.s 3-4 for the adhesive polymer and see col.4, lines 18 et seq and col.5, lines 1-60 for the AQ polymers. The polymer disclosed in the patent reads on the claimed adhesive polymer. See the examples for ethanol which read on the solvent, see col5, lines 60 et seq and col.6 for the additives.

9. Claims 50-52 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. patent 4,150,115 ('115).

CLAIM CONSTRUCTION

The claims are drawn to method and claims recite the functional language, which is *when the composition is dried, the resulting dried material has detachment profile defined by at least one maximum detachment force F_{max} of greater than 1N., wherein F_{max} , as measured by extensometer, is the maximum tensile force needed to detach the surfaces of two respective rigid, inert, nonabsorbent supports (A)and (B) , wherein said surfaces have each have a surface area of 38 mm² and wherein said supports are placed facing each other: and further wherein:*

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said surfaces are precoated at a concentration of $53/c$ micrograms/mm² with a formulation comprising said at least one adhesive polymer in the cosmetically acceptable medium, where in c is the concentration of solids in the formulation, expressed in grams per gram of composition ; and

said precoated surfaces are dried for 24 hours at 22° C, under a relative humidity of 50%, then subjected for 20 seconds to a compression of 3N, and then subjected to detachment at a speed of 20 mm/minute for 30 seconds to determine F_{max} .

The office is not equipped to manufacture the composition and then drying the composition and verify so that the composition satisfies the functional criteria recited in the method claims. Therefore the claims are anticipated.

See example IX at col.s 15-16. Polymer of example 2 reads on the adhesive polymer and the dyes disclose reads on the solid particles. The dyes are aminophenol base, nitro phenylamine diamine. See col.16, lines 8-12 which reads on the claimed method of ‘ providing color” and also enhancing sheen” and method for conditioning hair. The specification does not define the meaning for the expressions “ conditioning hair” and it is the examiners position the patent disclosing “ that the compositions are silky to touch and combs easily “ reads on the claimed method of “ conditioning hair”.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 47-48 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent '221 in view of U. S. Patent 5,639,448 ('448).

CLAIM CONSTRUCTION

The claims are drawn to method and claims recite the functional language, which is *when the composition is dried, the resulting dried material has detachment profile defined by at least one maximum detachment force F_{max} of greater than 1N., wherein F_{max} , as measured by extensometer, is the maximum tensile force needed to detach the surfaces of two respective rigid, inert, nonabsorbent supports (A) and (B), wherein said surfaces have each have a surface area of 38 mm^2 and wherein said supports are placed facing each other: and further wherein: said surfaces are precoated at a concentration of $53/c$ micrograms/ mm^2 with a formulation comprising said at least one adhesive polymer in the cosmetically acceptable medium, where in c is the concentration of solids in the formulation, expressed in grams per gram of composition; and said precoated surfaces are dried for 24 hours at 22°C , under a relative humidity of 50%, then*

subjected for 20 seconds to a compression of 3N, and then subjected to detachment at a speed of 20 mm/minute for 30 seconds to determine F_{max} .

13. **The office is not equipped to manufacture the composition and then drying the composition and verify so that the composition satisfies the functional criteria recited in the claims.**

Patent '221 teaches compositions and method of coloring hair (mascara) using adhesive polymer and solid particles. See above for all the relevant columns. The difference between the patent and the instant claims are the patent '221 does not teach the use of adhesive polymers for styling, which is same as holding or fixing the hair using solid particles and adhesive polymer. However patent '448 teaches the same adhesive polymers, which are aryl-sulfonated polymers for styling the hair. See col. 3, lines 49-57, col.4, lines 27-35, col.s 5-6, see example 1.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '221 and use the sulfonated polymers of '221 for fixing the hair in view of teaching of '448 that the sulfonated polymers are also useful for hair styling. This is a prima facie case of obviousness.

Claims 21-47,49 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents '221 and 6,495,119 ('119) and 5,932,201 ('201).

CLAIM CONSTRUCTION

The claims are drawn to method and claims recite the functional language, which is *when the composition is dried, the resulting dried material has detachment profile defined by at least one maximum detachment force F_{max} of greater than 1N., wherein F_{max} , as measured by extensometer, is the maximum tensile force needed to detach the surfaces of two respective rigid,*

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inert, nonabsorbent supports (A) and (B), wherein said surfaces have each have a surface area of

38 mm² and wherein said supports are placed facing each other: and further wherein:

said surfaces are precoated at a concentration of 53/c micrograms/mm² with a

formulation comprising said at least one adhesive polymer in the cosmetically acceptable

medium, where in c is the concentration of solids in the formulation, expressed in grams per gram of composition; and

said precoated surfaces are dried for 24 hours at 22^o C, under a relative humidity of 50%, then subjected for 20 seconds to a compression of 3N, and then subjected to detachment at a speed of 20 mm/minute for 30 seconds to determine F_{max}.

14. **The office is not equipped to manufacture the composition and then drying the composition and verify so that the composition satisfies the functional criteria recited in the claims.**

Patent '221 does not teach the limitations claimed in claims 39-41 drawn to solvents and additives claimed in claims 43-45. However patent '119 teaches compositions using the specific solvents claimed at col.6, lines 35-53 and also at lines 65-67. Patent '201 teaches compositions using thiols and silicones. See examples for thioglycolic acid, which are to thiols and see col.7, lines 42-64 and see line 64 for additive under silanes.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '221 and add the additives and solvents of '119 and '201, which are conventionally used in cosmetic compositions. Absent as showing the criticality of the additive claimed in claim 44 and the solid particles claimed in claim 27 which


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are to “ flakes, platelets, leaflets, fibrils” vs. powders taught by ‘221, the claims are rendered prima facie obvious over the combination of patents ‘221 and ‘119 and ‘201.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30: 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, THURMAN K. PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JYOTHSNA A VENKAT Ph. D
Primary Examiner
Art Unit 1615
